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21 UNITED STATES DISTRICT COURT
22 NORTHERN DISTRICT OF CALIFORNIA
23 SAN FRANCISCO DIVISION

24 GOOGLE LLC,
25 Plaintiff,
26 vs.
27 SONOS, INC.,
28 Defendant.

Case No. 3:20-cv-06754-WHA
Related to Case No. 3:21-cv-07559-WHA

**REPLY IN SUPPORT OF GOOGLE
LLC'S MOTION FOR
RECONSIDERATION OR
CLARIFICATION**

Location: Courtroom 12, 19th Floor
Judge: Hon. William Alsup

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1 I. INTRODUCTION

2 Sonos's opposition (Dkt. 448, "Opp.") fails to cite any case holding what Sonos asks this
 3 Court to hold: that a party waived an argument by not raising it in summary judgment papers that
 4 addressed separate issues. As Google explained (Dkt. 445, "Mem."), the Federal Circuit has held
 5 repeatedly that there is no waiver simply because a party chooses not to raise an issue on summary
 6 judgment. And a court may not grant summary judgment *sua sponte* without providing notice and
 7 an opportunity for the parties to present arguments as to why summary judgment should not be
 8 granted.

9 Faced with this case law directly on point, Sonos claims that the showdown procedure put
 10 Google on notice of a requirement to raise *all* invalidity arguments on summary judgment. But
 11 Sonos identifies no language in this Court's showdown order stating such a requirement because no
 12 such language exists. The showdown order required each party to choose one asserted patent claim
 13 and file one summary judgment motion for each claim, but said nothing about whether the parties
 14 needed to raise all issues on summary judgment. Indeed, Sonos concedes that Google did *not* have
 15 to raise invalidity on summary judgment, but argues that Google's raising some invalidity arguments
 16 required it to raise all invalidity arguments. The showdown order did not suggest, let alone expressly
 17 notify the parties of, this novel rule. And the Federal Circuit has expressly rejected it, holding that
 18 raising some invalidity arguments on summary judgment does not preclude a party from raising
 19 other invalidity arguments later. Moreover, Sonos's claim that Google cannot even raise the
 20 argument (on reconsideration) that it did not waive its invalidity arguments is meritless. According
 21 to Sonos, Google was required not only to raise its invalidity arguments in response to this Court's
 22 order to show cause, but also to preempt any argument (not yet made) that Google had waived those
 23 arguments. Sonos cites nothing in support of such a requirement.

24 Finally, to the extent this Court does not reconsider its summary judgment order, Google
 25 respectfully requests that it clarify that the summary judgment order is limited to claim 1 of U.S.
 26 Patent No. 10,848,885 ("the '885 patent"). Sonos does not oppose this relief.

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1 **II. THIS COURT SHOULD RECONSIDER ITS RULING THAT GOOGLE WAIVED**
 2 **BASES FOR INVALIDITY NOT RAISED ON SUMMARY JUDGMENT**

3 Sonos fails to confront the uniform case law holding that a party does not waive an argument
 4 by not raising it in a motion for summary judgment or in an opposition to summary judgment on a
 5 separate issue. *See Mem. 3-6.* Several of the cases Sonos simply ignores. *See Fin Control Systems*
 6 *Pty, Ltd. v. OAM, Inc.*, 265 F.3d 1311, 1321 (Fed. Cir. 2001) (vacating “the district court’s *sua*
 7 *sponite* grant of summary judgment of invalidity and unenforceability . . . because it did not provide
 8 the parties with adequate notice or an opportunity for FCS to present evidence and argument in
 9 opposition to the motion”); *NeuroGrafix v. Brainlab, Inc.*, 787 F. App’x 710, 717 (Fed. Cir. 2019)
 10 (“The MDL court’s ruling was contrary to those basic principles in that it granted summary
 11 judgment against NeuroGrafix for its failure to come forward with evidence to answer a non-
 12 infringement ground that had not been asserted and of which it had not been given proper notice.”);
 13 *Massey v. DelLab ’ys, Inc.*, 118 F.3d 1568, 1573 (Fed. Cir. 1997) (“Because the district court granted
 14 summary judgment to a non-movant on a ground for which a full and fair opportunity to proffer
 15 material evidence was not offered, this court must vacate and remand.”).

16 As to the cases Sonos does address, Sonos’s attempt to distinguish them fails. As Google
 17 explained (Mem. 3), *Mikkelsen Graphic Eng’g, Inc. v. Zund Am., Inc.*, 541 F. App’x 964 (Fed. Cir.
 18 2013) is directly on point. It held that when a patentee moves for summary judgment of
 19 infringement, and an alleged infringer raises some but not all arguments for invalidity, the other
 20 bases for invalidity are not waived. *Id.* at 972-74. Sonos suggests (Opp. 9) that *Mikkelsen* is
 21 different because there, the patentee did not ask for invalidity to be decided on summary judgment,
 22 whereas “Sonos explained that Google’s invalidity arguments failed as a matter of law.” But here,
 23 like in *Mikkelsen*, Sonos never moved for summary judgment of validity or otherwise asked the
 24 Court to determine validity as a matter of law; critically, at no time did Sonos attempt to meet its
 25 burden to show that there are no triable issues of fact with respect to validity. As Sonos itself states,
 26 Sonos responded only to those invalidity arguments that Google raised in opposition to Sonos’s
 27 motion for summary judgment of infringement. *See Dkt. 274 at 7-15.* Thus, just as in *Mikkelsen*,
 28 (i) the patentee never sought summary judgment of validity, (ii) in response to a motion for summary

1 judgment of infringement, the accused infringer raised some but not all of its invalidity arguments,
 2 and (iii) no other issue of validity or invalidity was raised or addressed by either party. As *Mikkelsen*
 3 found, in that context, there can be no waiver of the accused infringer's remaining invalidity
 4 arguments.

5 Similarly, *Mitutoyo Corp. v. Cent. Purchasing, LLC*, 499 F.3d 1284, 1291 (Fed. Cir. 2007),
 6 and *Euclid Chemical Co. v. Vector Corrosion Technologies, Inc.*, 561 F.3d 1340, 1345 (Fed. Cir.
 7 2009), held that not raising an issue on summary judgment is not a waiver. Sonos attempts (Opp.
 8 10) to distinguish those cases because "Google did raise invalidity on summary judgment," but as
 9 discussed above, *Mikkelsen* rejected this very argument. Moreover, this argument ignores the
 10 reasoning of *Mitutoyo* and *Euclid* that a party's "failure to so move [for summary judgment on an
 11 issue] likely indicates its sense that issues of material fact exist, not an intent to abandon its . . .
 12 claim." *Mitutoyo*, 499 F.3d at 1291; *see also Euclid*, 561 F.3d at 1345.¹ In any event, Google did
 13 not *move* for summary judgment of invalidity; it *opposed* Sonos's motion for summary judgment of
 14 infringement by raising some invalidity arguments. Sonos provides no legal or rational argument
 15 for treating an opposition raising one issue as the waiver of another.

16 Sonos's only other argument to try to distinguish these cases is the incorrect assertion (Opp.
 17 1, 6-7) that this Court's showdown procedure required Google to raise all issues in opposing
 18 summary judgment. Contrary to Sonos's claim (Opp. 1) that "Google does not even acknowledge
 19 the Court's unique showdown procedure," Google explained exactly why that procedure does not
 20 support waiver here: because it said nothing about a requirement to raise *all* issues on summary
 21 judgment. Mem. 5. Sonos cites (Opp. 6-7) paragraphs 1 and 2 of the showdown order. *See* Dkt.
 22 68. Paragraph 1 states that the "patent owner and alleged infringer shall each select and exchange
 23 one asserted claim — presumably the strongest case for infringement and strongest case for

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 25 ¹ Sonos's suggestion (Opp. 6 n.1, 11) that Google's other invalidity arguments must be weak, or
 26 else Google would have raised them on summary judgment, ignores this point. Some arguments
 27 are more or less amenable to resolution on summary judgment than others, for instance because
 28 some may involve factual issues or because some may come into sharper focus once a claim is
 interpreted in another context. *See* Dkt. 351 at 9-10. Regardless, Sonos fails to address the merits
 of the invalidity arguments Google raised in response to the order to show cause, and thus Sonos
 provides no basis to question the merits of those arguments.

1 noninfringement or invalidity, respectively.” *Id.* ¶ 1. Sonos selected claim 1 of the ’885 patent,
 2 which obviously has nothing to do with waiver. Paragraph 2 states that “[t]he parties shall file cross
 3 motions for summary judgment on the two claims (one for each party) selected for the patent
 4 showdown. The parties are limited to **ONE MOTION EACH REGARDLESS OF THE**
 5 **NUMBER OF ISSUES RAISED**, e.g. standing, invalidity, noninfringement, etc.” *Id.* ¶ 2. This
 6 sentence, by its very terms, does not say that all issues (“standing, invalidity, noninfringement, etc.”)
 7 *must* be raised, but rather that any number of issues *can* be raised, so long as it is done in one motion.

8 Sonos’s argument seems to be that, because the showdown order did not affirmatively state
 9 that Google could make arguments not raised on summary judgment, Google cannot do so, but that
 10 gets the law backwards. A court “may not sua sponte grant summary judgment on a particular
 11 ground without giving the non-moving party notice and an opportunity to present evidence and
 12 argument in opposition.” *Eon-Net LP v. Flagstar Bancorp*, 249 F. App’x 189, 193-94 (Fed. Cir.
 13 2007). Here, the *lack* of a statement on this issue in the showdown order does not constitute notice
 14 that Google was required to present all invalidity arguments at summary judgment. Moreover, a
 15 party does not waive arguments any time a court does not expressly permit them; rather, it waives
 16 them when there is a clear requirement to raise them at a particular time, such that not raising them
 17 constitutes “knowing[] and intelligent[] relinquish[ment].” *Wood v. Milyard*, 132 S. Ct. 1826, 1832
 18 n.4 (2012). There was no such clear requirement—indeed, no suggestion at all—in the showdown
 19 order. In any event, as Google explained (Mem. 5), Google has a right to argue invalidity based on
 20 this Court’s claim construction. *See Mikkelsen*, 541 F. App’x at 973.²

21 Sonos’s reliance (Opp. 9) on *Pandrol USA, LP v. Airboss Ry. Prods., Inc.*, 320 F.3d 1354
 22 (Fed. Cir. 2003), only confirms the error of Sonos’s argument. In *Pandrol*, the Federal Circuit held
 23 that “the issue of invalidity is a separate issue from infringement, and an alleged infringer’s failure

25 ² Sonos’s argument (Opp. 12) that the claim construction was not entirely new misses the point. In
 26 the Court’s ruling on Sonos’s motion for summary judgment of infringement, this Court ruled that
 27 “Judge Albright’s oral claim construction rulings are not and were never the law of the case.” Dkt.
 28 382 at 2. And this Court recognized that it went beyond the construction Judge Albright adopted
 because its order “additionally found that the requirement that ‘zone scenes’ must be formed
 ‘according to a common theme’ could be satisfied by allowing users to name and save speaker
 groups.” *Id.* at 2. This construction significantly strengthens multiple invalidity arguments that
 were not raised or decided in the context of Sonos’s motion for summary judgment of infringement.

1 to raise it in opposition to a motion for summary judgment of infringement is not a waiver.” *Id.* at
 2 1365. Sonos also cites *Albino v. Baca*, 747 F.3d 1162, 1177 (9th Cir. 2014), for the proposition that
 3 “[a]s the movants for summary judgment in this case, defendants were on notice of the need to come
 4 forward with all their evidence in support of this motion, and they had every incentive to do so.”
 5 Opp. 9. But the question here is not whether Google had to come forward with all **evidence** in
 6 support of a particular argument, but whether it had to raise all arguments for invalidity in opposition
 7 to Sonos’s motion for summary judgment of infringement. As a matter of law, it did not.

8 Sonos likewise errs in relying (Opp. 7-8) on this Court’s cases involving showdown
 9 procedures. Sonos cites *Synkloud Technologies, LLC v. Adobe, Inc.*, No. 3:20-cv-07760-WHA
 10 (N.D. Cal. Nov. 3, 2020), but *Synkloud* confirms Google’s argument. *See Mem.* 6 n.1. In *Synkloud*,
 11 this Court rejected a cross-motion for invalidity raised at the same time as the opposition, in violation
 12 of the “one motion” rule of the showdown procedure. *See id.*, Dkt. 146 at 1-2. But even while
 13 striking the cross-motion, this Court ruled that the alleged infringer could still make its invalidity
 14 arguments and would not be deemed to have waived any such arguments: “While this order
 15 disregards Adobe’s cross-motion, it *will* consider all of Adobe’s substantive arguments, including
 16 invalidity as a defense to infringement, as opposition briefing to Synkloud’s summary judgment
 17 motion. *This order should not be construed to preclude Adobe from moving for a declaration of*
 18 *invalidity for claim 9 in the future.*” *Id.* at 2 (emphasis in original and added). Sonos also cites
 19 *Finjan, Inc. v. Juniper Networks, Inc.*, No. 3:17-cv-05659-WHA (N.D. Cal. Sept. 29, 2017), but
 20 *Finjan* said nothing about waiver. *See Mem.* 6 n.1. Sonos asserts (Opp. 7) that “[w]hile the Court’s
 21 final pretrial order governing the showdown trial did not explicitly say that Juniper could not raise
 22 §§ 102 and 103, the Court’s order implicitly held as much.” But *Finjan* did not suggest any such
 23 restriction on Juniper’s ability to raise section 102 and 103 issues, much less that they were waived.
 24 In the parties’ proposed joint pretrial order, Juniper “recognize[d] that those issues will be decided
 25 at a later phase in the litigation.” *Finjan*, Dkt. 262 at 6 n.3. And while not addressing section 102
 26 and 103 issues, this Court’s pretrial order “ADOPT[ED] defendant Juniper Network, Inc.’s position
 27 regarding the factual issues to be tried (Dkt. No. 262 at 7-8) except to the extent modified by orders
 28

1 in limine.” Dkt. 301 at 1. Thus, at no point did this Court reject Juniper’s reservation of rights.³

2 Finally, Sonos’s assertion (Opp. 4-5) that Google waived the argument that it did not waive
 3 its invalidity arguments is meritless. Sonos notes (Opp. 4) that “the Court’s order to show cause
 4 plainly put the parties on notice of the fact that the Court was contemplating granting summary
 5 judgment of validity.” That is true, and that is why Google’s response to this Court’s order to show
 6 cause clearly and unequivocally raised Google’s invalidity arguments, which Google had also
 7 notified Sonos about in expert reports and invalidity contentions. Mem. 4-5. This Court’s order to
 8 show cause did not suggest—and thus Google had no reason to address at that time—that the Court
 9 would not consider the merits of Google’s other arguments on invalidity. The first time anyone
 10 mentioned waiver was Sonos’s response to this Court’s order to show cause, to which Google had
 11 no opportunity to respond. Sonos’s argument thus amounts to the idea that to preserve an argument,
 12 a party needs to not only raise that argument, but anticipate and preempt the opposing party’s
 13 potential claim of waiver. Sonos cites no case for this proposition, and Google is aware of none.

14 **III. THIS COURT SHOULD CLARIFY THAT THE ORDER IS LIMITED TO CLAIM**
1 OF THE ’885 PATENT

15 Sonos does not dispute, nor could it, that this Court should clarify that the Order is confined
 16 to claim 1 and does not establish validity of the patent as a whole. Sonos states (Opp. 1) it “has no
 17 problem with the Court clarifying that its order only applies to claim 1, as that was the only ’885
 18 patent claim at issue in the showdown procedure, and the other ’885 patent claims are out.” *See*
 19 *also* Opp. 13 (“To be clear, to the extent the Court believes any further clarification is needed, Sonos
 20 agrees that the summary judgment order applies only to claim 1 of the ’885 patent and Sonos will
 21 not be presenting any evidence of infringement of any other claims of the ’885 patent at trial.”).
 22 While Sonos asserts (Opp. 13) that it “attempted [to] reach agreement with Google to moot this
 23 dispute without requiring the Court’s involvement,” Sonos’s proposal would not have adequately

25
 26 ³ Sonos also suggests (Opp. 1) that allowing Google to raise its invalidity arguments would “defeat
 27 the entire purpose of the showdown procedure.” But Sonos concedes (Opp. 9) that Google could
 28 have said nothing about invalidity and thus preserved all invalidity arguments for trial. The purpose
 of the showdown procedure would not be furthered by finding waiver where a party raises some
 invalidity arguments in opposition to a motion for summary judgment of infringement, thereby
 encouraging them to raise none.

1 addressed the fact that the Court's Order does not limit its ruling to the claim at issue. Because both
2 parties recognize that the ruling should be so limited, Google respectfully requests that this Court
3 clarify that the Order is limited to claim 1.

4 **IV. CONCLUSION**

5 For the foregoing reasons and those stated in Google's motion, Google respectfully requests
6 that this Court grant reconsideration of the Order, vacate the entry of summary judgment as to
7 validity, and make clear that the Order is limited to claim 1.

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9 DATED: January 25, 2023

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CERTIFICATE OF SERVICE

Pursuant to the Federal Rules of Civil Procedure and Local Rule 5-1, I hereby certify that, on January 25, 2023, all counsel of record who have appeared in this case are being served with a copy of the foregoing via the Court's CM/ECF system and email.

/s/ Charles K. Verhoeven
Charles K. Verhoeven